

Notice of Allowability

Application No.

09/758,967

Examiner

Nga B. Nguyen

Applicant(s)

BLOOM ET AL.

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the Amendment filed on September 11, 2006.
2. ☒ The allowed claim(s) is/are 1-34.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

1. This Office Action is the answer to the Amendment filed on October 3, 2006, which paper has been placed of record in the file.
2. Claims 1-34 are pending in this application.

Examiner's Amendment

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in the telephone interview with Mr. Denis Maloney on December 7, 2006.

There are two claims numbered "33", replacing the claim numbered "33" (second one) by number 34.

Allowable Subject Matter/Reasons for Allowance

4. Claims 1, 11, 16, 17, 18 and 24 are allowed over the prior arts cited records.

The closets prior arts are:

1) Olienyk et al. (Journal of Financial Planning) discloses a new type of index fund called World Equity Benchmark Shares (WEBS), which trade on the American Stock Exchange. WEBS are a hybrid security, offering some of the introduced in March

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1996 by Morgan Stanley and trade on the American Stock Exchange. WEBS offer a pure play on a single country's market index.

2) iShares, Inc (Business Wire) disclose iShares are index funds that are bought and sold like common stocks on a national securities exchange. This flexibility enables investors to purchase and sell shares through any brokerage firm, financial advisor, or online broker, and hold the funds in any type of brokerage account. Similar to many index funds, iShares have relatively low portfolio turnover, which reduces transaction costs incurred by the Fund and minimizes capital gains distributions to investors, iShares also offer the diversification of index investing, and institutional-quality investment management from the world's largest manager of index funds. Similar to stocks, iShares can be traded anytime during normal market hours, and priced intra-day so investors know the value of their investments.

Therefore, it is clear from the description of Olienyk et al's and iShares, Inc inventions that the prior arts do not considered the possibility of: a field that identifies an index of securities that are traded in a second, different country that the first fund is based on and being arbitragable with a second fund that is based on the index and which is registered in the second different country with the first fund having a creation unit basis that is substantially the same as a creation unit basis for the second fund, as included in claim 1; a field identifying a second tracking fund being based on an index of securities the second fund traded in a second, different country and registered in the second country; wherein the first tracking fund is structured with a creation unit basis that is substantially the same creation unit basis as for the second fund and where

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calculation of the net asset value of the first fund occurs essentially or exactly the same time that second country fund has its NAV calculated, as included in claim 11; administering in a computer system a first fund, the first fund having a creation unit basis that is substantially the same creation unit basis as a creation unit basis for a second fund that is traded on a second marketplace in a different country from as the first fund, as included in claim 16; calculating in the computer, the net asset value of the first fund at essentially or exactly the same time that the net asset value of a second country fund has its net asset value calculated, with the first fund and the second fund each tracking the same index of financial products, as included in claims 17, 18 and 24.

5. Claims (2-10), (12-15), (33-34), (19-23) and (25-32), are allowed because they are dependent claims of the allowable independents 1, 11, 16, 18 and 24 above, in that order.

Conclusion

6. Claims **1-34** are allowable.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on (571) 272-6777.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-1113.

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:

(703) 872-9306 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox Building, 501 Dulany Street, Alexandria, VA, First Floor (Receptionist).



NGA NGUYEN
PRIMARY EXAMINER

December 7, 2006